

Application No. 10/028,574
Amdt. Dated: March 19, 2007
Reply to Office Action Dated: December 18, 2006
Customer No.: 24737

Remarks/Arguments

The Examiner is thanked for the Office Action dated December 18, 2006. The status of the application is as follows:

- The specification stands objected to for failing to provide proper antecedent basis for claim 22.
- Claims 1-4, 8-11, 15-18, 22, 26, and 31 stand rejected under 35 U.S.C. 102(b) as being anticipated by Harrison (US 5,878,222).
- Claims 5, 12, and 19 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Harrison in view of Liebenow (US 6,601,074).
- Claims 6, 7, 13, 14, 20, and 21 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Harrison in view of Zigmond et al. (US 6,400,407).
- Claim 23 stands rejected under 35 U.S.C. 103(a) as being unpatentable over Harrison in view of Inaba (US 5,880,789).
- Claims 24, 25, 28, and 30 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Harrison in view of Williams et al. (US 5,945,988).
- Claim 27 stands rejected under 35 U.S.C. 103(a) as being unpatentable over Harrison in view of Holtz et al. (US Pub. No. 2002/0053078).
- Claim 29 stands rejected under 35 U.S.C. 103(a) as being unpatentable over Harrison in view of Lewis (US Pub. No. 2003/0040962).

The objection and rejections to the claims are discussed below.

Claim Objection

The specification stands objected to as failing to provide proper antecedent basis for the term "datastream" in claim 22. It is noted that claim 22 was incorporated into the specification at page 4, line 1, in response to the Final Office Action dated August 8, 2006 to cure this objection. This amendment was made pursuant to MPEP §2163.06 (The claims as filed in the original

Application No. 10/028,574
Amdt. Dated: March 19, 2007
Reply to Office Action Dated: December 18, 2006
Customer No.: 24737

specification are part of the disclosure and therefore, if an application as originally filed contains a claim disclosing material not disclosed in the remainder of the specification, the applicant may amend the specification to include the claimed subject matter. *In re Benno*, 768 F.2d 1340, 226 (Fed. Cir. 1985). Accordingly, this objection should be withdrawn.

The Rejection of Claims 1-4, 8-11, 15-18, 22, 26, and 31 under 35 U.S.C. 102(b) as being anticipated by Harrison (US 5,878,222).

Claims 1-4, 8-11, 15-18, 22, 26, and 31 stand rejected under 35 U.S.C. 102(b) as being anticipated by Harrison. This rejection should be withdrawn because Harrison does not teach each and every element as set forth in the subject claims.

A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631 (Fed. Cir. 1987).The identical invention must be shown as recited in the claim (*Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236 (Fed. Cir. 1989)). The elements must be arranged as required by the claim (*In re Bond*, 910 F.2d 831 (Fed. Cir. 1990)).

MPEP §2131.

Independent **claim 1** is directed towards a system for extending unattended control capabilities for a video receiver and recites that the system includes, *inter alia*, a shell that executes scripts that control demodulation of broadcast programming and at least one executing script that selects broadcast programming for demodulation. Harrison does not teach or suggest these claimed aspects.

Harrison is directed towards selecting a channel for display from among a plurality of channels based on corresponding program content. As such, Harrison discloses a multimedia system having an analyzing unit 250/585 that analyzes data indicative of an airing program for a number of different channels to determine if any airing program includes information of interest to a viewer based on a user profile stored in a profile unit 260/583. An arbitrating unit 270/587 selects a program to display from among a plurality of airing programs when more than one channel airs a program having information of interest to the viewer. This decision is based on

user-defined priorities stored in the profile. (See Abstract).

As pointed out by the Office in the subject Office Action, the system of Harrison includes a profile unit 260/583 that stores profiles, including channel identification, user specified channel priority information, triggers such as keywords for searching, and actions to be taken upon locating an airing of a program that includes a matching trigger. The Office asserts that this stored profile teaches executable scripts as recited in the subject claim since the profile includes text that indicates a particular action to be taken upon locating an airing program including predefined viewer items of interest.

However, Harrison teaches that an analyzing unit 250/585, upon detecting trigger data in an airing program, reads the action storage location of the profile to determine the action to take. (See column 5, lines 16-19). Then, the analyzing unit 250/585, depending on the priority of the currently displayed channel, performs the action. Thus, the profile is not an *executable script* as recited in the subject claim; it is more analogous to a data structure that stores textual indicia indicative of an action(s) to be taken by the analyzing unit 250/585. That is, the profile contains data that is read by the analyzing unit 250/585. The profile is accessed for the data. The profile is not executed. For instance, the "Action" column in the table presented in Fig. 3B includes textual indicia such as "Video ON," "Audio ON," "Maximize," and "Record." Such indicia identifies a type of action to be performed, but none of this indicia includes executable instructions for performing the action. Harrison does not contemplate executable profiles or executing a profile, and the profile does not execute to select the channel to display.

The Office further points out that the profile unit 260/583 can be programmed and re-programmed using an interactive program or user interface as shown in Figures 3a and 3b. Figure 5 explicitly shows the user interface in communication with the profile unit 583. The Office also points out that the profile in profile unit 260/583 is ultimately communicated to the analyzing unit 250/585 and the arbitrating unit 270/587, which determine the program to display. Thus, the user interface is used to generate the profile and the analyzing unit 250/585 and the arbitrating unit 270/587 are used to determine the program to display. The Office also states that a shell is an interactive program that *creates and runs scripts*. Since none of the user interface,

the analyzing unit 250/385, or the arbitrating unit 270/387 *creates and runs scripts*, none of these components teach or suggest a shell as recited in the subject claim.

In view of the above, it is readily apparent that Harrison does not teach or suggest a shell that executes scripts that control demodulation of broadcast programming or an executable script to select broadcast programming as recited in the subject claim.

Claim 2, which depends from claim 1, has been amended herein to recite that the at least one script identifies the one or more concurrently airing programs by searching a program guide received with broadcast programs from an external source, wherein the program guide describes program content of the broadcast programs and is periodically updated via subsequent reception of broadcast programs. Harrison does not teach or suggest these claimed aspects. Accordingly, this rejection should be withdrawn.

Claim 3, which depends from claim 1, has been amended herein to recite that the shell is an interactive program employed to create and run the at least one script that selects the broadcast programming. As discussed above in connection with claim 1, Harrison discloses a user interface that is used to program and re-program a profile unit 260/583; the user interface does not run scripts that select broadcast programming and the profile unit 260/383 does not store executable scripts. Harrison also discloses an analyzing unit 260/285 and an arbitrating unit 270/387 that facilitate selection of a channel to display; the analyzing unit 260/285 and the arbitrating unit 270/387 do not create and run scripts that select broadcast programming. In light of this amendment, the rejection of claim 3 should be withdrawn.

Claim 4, which depends from claim 1, has been amended herein to recite that the at least one script, when executed by the shell, controls operation of the video receiver to cause broadcast of commercials for a particular product to be demodulated and transmitted to a recording device. Harrison does not contemplate such selective control over the demodulation of commercials. Accordingly, this rejection should be withdrawn.

Independent **claim 8** is directed towards a video receiver that includes, *inter alia*, a shell having a script manager that creates executable scripts that control demodulation of broadcast

programming and a script executor that executes the created executable scripts, and a memory that stores scripts created by the shell. Claim 8 further recites that the shell executes at least one stored script and that the executing script selects broadcast programming for demodulation. As discussed above, Harrison does not teach or suggest a shell that creates and runs such executable scripts. Therefore, Harrison cannot teach or suggest that the shell includes a script manager and a script executor as recited in the subject claim. In view of the above, this rejection should be withdrawn.

Claim 9, which depends from claim 8, has been amended herein to recite that the at least one script identifies the selected broadcast programming from descriptive criteria in a description of the selected broadcast programming from a program guide that is received along with the broadcast programming and stored in the memory. Harrison does not contemplate using program guide information, let alone selecting broadcast programming based on received program guide information. Instead, Harrison searches signals indicative of decoded television programs for triggers such as keywords. Accordingly, this rejection should be withdrawn.

Claim 10 depends from claim 8, and by virtue of this dependency, is allowable for at least the reasons discussed above in connection with claim 8.

Claim 11, which depends from claim 8, recites that the at least one script executed by the shell controls operation of the video receiver to cause the selected broadcast programming to be demodulated and transmitted to a recording device. In contrast, Harrison discloses that an arbitrating unit 270/385 (and not a script being executed by a shell) determines which channel to display/record on the display/record unit based on textual indicia stored in a data structure such as a profile. (See column 4, lines 8-11 and 54-56). Thus, the rejection of claim 11 should be withdrawn.

Independent **claim 15** recites a method for extending unattended control capabilities for a video receiver including, *inter alia*, using an interactive program of the video receiver that creates and executes scripts to execute a script that selects a broadcast program to demodulate, wherein the script is executed by the shell to select broadcast programming for demodulation. As noted with respect to system claim 1, Harrison does not teach or suggest an interactive

program that creates and executes such scripts. Rather, Harrison discloses a user interface for programming and re-programming a user profile with textual indicia and analyzing / arbitrating units that determines a channel from among a plurality of channels to display. Accordingly, Harrison does not anticipate claim 15, and it is respectfully requested that this rejection be withdrawn.

Claims 16, 17, and 18 depend from claim 15, and by virtue of their dependency, are allowable for at least the reasons discussed above in connection with claim 15.

Independent **claim 22** recites, *inter alia*, a datastream stored on computer readable medium for use with a video receiver wherein the datastream includes one or more computer readable fields for a broadcast programming stream including selected broadcast programming and at least one script including a sequence of commands for causing the video receiver to demodulate the selected broadcast programming for display or recording, wherein the at least one script is executable by a shell running within the video receiver. As discussed previously, Harrison does not teach or suggest a shell that executes a script that selects demodulation of selected broadcast programming, let alone a datastream that includes such an executable script. Accordingly, this rejection should be withdrawn.

Claim 26, which depends from claim 11, recites that the scripting system further includes a script manager that schedules the script for execution. As known to one of ordinary skill in the relevant art, scheduling has meant designating a fixed time at which something is to occur. As such, claim 26 refers to designating a fixed time for the execution of the executable script. The Office references Harrison column 5, lines 35-40, and Figure 3A to teach the claimed script manager. However, this section and figure of Harrison do not teach or suggest such claimed aspect.

Rather, the referenced section and figure of Harrison disclose a user profile that includes trigger information such as keywords and a text entry indicative of an action to be performed. The indicated action is not tied to a fixed time. Instead, performance of the action is conditional in that it is tied to detecting the trigger information in a decoded television program signal. Thus, if the trigger information is never detected, then the condition to perform the action is

Application No. 10/028,574
Amdt. Dated: March 19, 2007
Reply to Office Action Dated: December 18, 2006
Customer No.: 24737

never met, and the action will never be performed. Hence, the action has not been scheduled to occur. In light of the above, this rejection should be withdrawn.

Claim 31, which depends from claim 22, recites that the shell enters an idle state when a script end time is reached and remains in the idle state until another script is selected for execution. Harrison does not teach or suggest such aspects. Therefore, this rejection should be withdrawn.

Moreover, it is noted that with respect to claim 31, the subject Office Action does not establish a *prima facie* case of anticipation because it does not identify which features of the prior art correspond to the claimed elements and limitations. To meet the burden of establishing a *prima facie* case of anticipation, the Office must explain how the rejected claim is anticipated by pointing out where the specific limitations of the claims are found in the prior art. (See *Ex Parte Naoya Isoda*, Appeal No. 2005-2289, Application 10/064,508 (Bd. Pat. App. & Inter.2005)).

The goal of examination is to clearly articulate any rejection early in the prosecution process so that the applicant has the opportunity to provide evidence of patentability and otherwise reply completely at the earliest opportunity. (See MPEP §706). The pertinence of each reference, if not apparent, must be clearly explained and each rejected claim specified. (37 C.F.R. §1.104(c)(2)).

Applicant requests specific identification of each feature or element of claim 31 in the cited reference which is deemed to correspond to the claimed elements and limitations, and if possible the location in the cited reference where the relevant feature or element is discussed.

The Rejection of Claims 5, 12, and 19 under 35 U.S.C. 103(a) as being unpatentable over Harrison in view of Liebenow (US 6,601,074).

Claims 5, 12, and 19 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Harrison in view of Liebenow. The rejection of these claims is respectfully requested in view of the following comments.

Claim 5, which depends from claim 1, has been amended herein to recite that the at least one script, when executed by the shell, controls operation of the video receiver to cause

broadcast only of commercials that provide sales information as private data along with broadcast program content. Harrison does not contemplate such aspects. Accordingly, this rejection should be withdrawn.

Claims 12 and 19 respectively depend from independent claims 8 and 15, and by virtue of their dependencies, are allowable for at least the reasons discussed above in connection with claims 8 and 15.

The Rejection of Claims 6, 7, 13, 14, 20, and 21 under 35 U.S.C. 103(a) as being unpatentable over Harrison in view of Zigmond et al. (US 6,400,407).

Claims 6, 7, 13, 14, 20, and 21 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Harrison in view of Zigmond et al. The rejection of these claims should be withdrawn because Harrison in view of Zigmond et al. does not teach or suggest all the claim limitations, and, thus, the Office has failed to establish a *prima facie* case of obviousness.

To establish a *prima facie* case of obviousness.... [T]he prior art reference (or references when combined) must teach or suggest all the claim limitations.

MPEP §2143

Claims 6, 13 and 20 recite that the at least one script is received with a broadcast programming stream, and **claims 7, 14 and 21** recite that the at least one script is received from an external source separate from a broadcast programming stream. The Office concedes that Harrison does not teach such aspects and attempts to use Zigmond et al. to make up for the conceded deficiencies. The Office asserts that Zigmond et al. teaches such aspects and that it would be obvious to one of ordinary skill in the relevant art at the time of the invention to combine the teachings to render the claimed invention.

However, Zigmond et al. does not teach or suggest these claimed aspects. Zigmond et al. discloses receiving logical address links in a broadcast video signal or from suppliers. If a logical address link is valid, an indication that the logical address link is associated with a currently viewed television program is visually and/or audibly provided to the viewer (See column 9, lines 17-24). If the logical address link is not valid, then no indication is provided to

Application No. 10/028,574
Amdt. Dated: March 19, 2007
Reply to Office Action Dated: December 18, 2006
Customer No.: 24737

the viewer. (See column 9, lines 31-32). Such links are not executable scripts that demodulate selected broadcast programming as recited in the subject claims and, thus, do not make up for the conceded deficiencies. Accordingly, the rejection of claims 6, 7, 13, 14, 20, and 21 should be withdrawn.

The Rejection of Claim 23 under 35 U.S.C. 103(a) as being unpatentable over Harrison in view of Inaba.

Claim 23 stands rejected under 35 U.S.C. 103(a) as being unpatentable over Harrison in view of Inaba. This rejection should be withdrawn because the Office has failed to provide the requisite suggestion or motivation to modify Harrison with the teachings of Inaba as purported in the Office Action and such modification does not teach or suggest the subject claim. Thus, the Office has not established a *prima facie* case of obviousness.

To establish a *prima facie* case of obviousness.... [T]here must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings.Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.

The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure. *In re Vaeck*, 947 F.2d 488 (Fed. Cir. 1991).

MPEP §2143

Claim 23, which depends from independent claim 1, recites that the shell executes a script that selects the broadcast programming for demodulation when a user manually initiates execution of the script by selecting a script execute option.

The Office concedes that Harrison does not teach or suggest such claimed aspects. In an attempt to remedy this conceded deficiency, the Office references Inaba column 3, line 66 to column 4, line 8, and asserts that it would have been obvious to one skilled in the relevant art to modify Harrison in view of this section of Inaba to teach the subject claim. The Office states that the motivation to make such modification is that it would provide greater user control over a

television receiving device. However, the Office does not cite either reference or the knowledge generally available to one of ordinary skill in the art to support this assertion. Thus, the Office has failed to provide the requisite suggestion or motivation for such modification to Harrison, and, thus, has not established a *prima facie* case of obviousness.

In addition, Inaba is directed towards an apparatus that displays supplemental data with an airing television program. (See Inaba column 3, lines 55-59). The supplemental data is transmitted in vertical blinking intervals of television signals and defines the procedure for establishing bidirectional telecommunication. (See Inaba column 3, lines 62-65). A decoder displays a symbol on the television screen when the supplemental data is available for the current airing program in order to notify the user of the availability of the supplemental data. (See Inaba column 4, lines 1-6). When the viewer keys in a suitable command, the supplemental data is displayed to the viewer. (See Inaba column 4, lines 6-8).

Harrison discloses that a problem with many traditional televisions is that the viewer is limited to manually selecting programming from concurrently airing programming to display on a television screen. (See Harrison column 1, lines 32-35). Harrison then states that what is needed is a system that automatically selects and displays programming based on programming content. (See Harrison column 2, lines 1-3). As noted above, Inaba requires a viewer look for a symbol to be displayed on the television screen and then to key in commands in order to have supplemental data displayed on the television screen. This teaching of Inaba is in contrast with the objective of Harrison because it removes the automaticity and requires an action by the viewer to select and display programming - the supplemental data. As such, the viewer would be limited to manually selecting programming (supplemental data) to display on the television screen, which is the problem Harrison is attempting to overcome. Thus, there is not suggestion or motivation to modify Harrison as purported.

Moreover, the pre-selected supplemental data does not select a television program from a plurality of airing television programs to display. Thus, if Harrison were modified with this teaching of Inaba, the result would not teach or suggest user manual initiation of the execution of a script that selects a program from a plurality of programs to demodulate for display. Rather, it

Application No. 10/028,574
Amdt. Dated: March 19, 2007
Reply to Office Action Dated: December 18, 2006
Customer No.: 24737

would allow a user to manually decide whether to display pre-selected supplemental data for a television program while watching the television program.

In view of the above, Harrison in view of Inaba does not make obvious the claim 23. Therefore, it is respectfully requested that the rejection of claim 23 be withdrawn.

The Rejection of Claims 24, 25, 28, and 30 under 35 U.S.C. 103(a) as being unpatentable over Harrison in view of Williams et al.

Claims 24, 25, 28, and 30 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Harrison in view of Williams et al.

With respect to **claim 24**, this rejection should be withdrawn because the Office has failed to provide the requisite suggestion or motivation to modify Harrison with the teachings of Williams et al. as purported in the Office Action and such modification would change the principle of operation of Harrison, and, thus, the Office has not established a *prima facie* case of obviousness.

To establish a *prima facie* case of obviousness.... [T]here must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings....

The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure. *In re Vaeck*, 947 F.2d 488 (Fed. Cir. 1991).

MPEP §2143

If the proposed modification or combination of the prior art would change the principle of operation of the primary reference, then the teachings of the references are not sufficient to render the claims *prima facie* obvious. *In re Ratti*, 270 F.2d 810 (CCPA 1959) (reversing the rejection, holding that the suggested modification would require a change in the principle under which the primary reference was designed to operate).

MPEP §2143.01

Claim 24, which depends from independent claim 1, recites that the shell automatically periodically executes the script to check future programming. The Office concedes that Harrison does not teach or suggest this claimed aspect. In an attempt to remedy this conceded deficiency, the Office references Williams et al. and asserts that it would have been obvious to one skilled in the relevant art to modify Harrison in view of Williams et al. to teach the subject claim. The Office states that the motivation to modify the profile of Harrison to include periodic searching for future programming is to prevent a user from missing programming matching their interests. However, the Office does not cite either reference or the knowledge generally available to one of ordinary skill in the art to support this assertion. Thus, the Office has failed to provide the requisite suggestion or motivation for such modification to Harrison, and, thus, has not established a *prima facie* case of obviousness.

In addition, Williams et al. is directed towards automatically updating user preferences in an entertainment system. (See Abstract). In the sections of Williams et al. cited by the Office, Williams et al. discloses a controller 104 that generates and stores user profiles (See column 2, line 66 to column 3, line 2) and that provides programming suggestions (See column 12, lines 6-10), and a profile database 700 that stores user-provided search requests (See column 11, lines 31-38). As disclosed in Williams et al., given a particular search request, the controller 104 searches programming information each time it receives updated programming information and prompts the user with suggested programming. (See column 11, lines 20-27 and 38-43). The user can then select to view the program. (See column 11, lines 27-30 and 43-44).

As noted above, Harrison is directed towards selecting a television program to display from a plurality of programs concurrently airing on a plurality of different channels. Harrison discloses that the television programs are received by tuning units (See column 3, lines 34-37 and column 4, lines 17-19) and that the television programs are converted to data streams by decoding units (See column 3, lines 49-51 and column 4, lines 19-26). The data streams are fed to analyzing units, which determine whether any of the received programs includes a predefined item of interest stored in the profile unit 260. (See column 3, lines 51-56 and column 4, lines 40-42). The items of interest stored in the profile unit 260 include user-provided search requests or

Application No. 10/028,574
Amdt. Dated: March 19, 2007
Reply to Office Action Dated: December 18, 2006
Customer No.: 24737

triggers such as keywords. (See column 4, lines 43-50). If a program includes a predefined item of interest, it is then displayed to the viewer. (See column 4, lines 8-11).

Based on the teachings of the references, modifying Harrison with the user provided search requests of Williams et al. would not provide for periodic execution of a script to check *future* programming as recited in the subject claim since Harrison analyzes *television programs as the television programs are received and decoded*, and not future broadcast programming information. At most, the search requests of Williams et al. could be used along with the triggers of Harrison to search television programs as they are received. In order to search future programming, the principle of operation of Harrison would have to be changed so that Harrison would also begin to receive future programming information.

In light of the above, Harrison in view of Williams et al. does not make obvious claim 24. Therefore, it is respectfully requested that the rejection of claim 24 be withdrawn.

Claim 25 has been amended herein to recite that the executing script selects the broadcast programming based on an identity of a viewer, which is a condition to automatically choose content appropriate for the viewer. Support for this amendment is found at page 17, lines 1-5. Neither Harrison nor Williams et al. teach or suggest that the identity of the viewer is a condition to automatically choose content appropriate for the viewer.

Williams et al. discloses configuring system setting based on user preferences in a user profile corresponding to the identified user; however, Williams et al. does not teach or suggest automatic selection of *appropriate content* for the viewer based on the user identity as recited in the subject claim. Rather, Williams et al. teaches simply using the user preferences for the identified user and does not take into account whether such preferences result in the automatic selection of inappropriate content for the viewer. Accordingly, the rejection of claim 25 should be withdrawn.

With respect to **claim 28**, this rejection should be withdrawn because the Office has failed to provide the requisite suggestion or motivation to modify Harrison with the teaching of

Inaba as purported in the Office Action and such modification does not teach or suggest the subject claim, and, thus, the Office has failed to establish a *prima facie* case of obviousness.

To establish a *prima facie* case of obviousness.... [T]here must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings.Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.

The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure. *In re Vaeck*, 947 F.2d 488 (Fed. Cir. 1991).

MPEP §2143

Claim 28, which depends from independent claim 1, recites that the script ranks alternative programs for display or recording by automatically extrapolating from a viewing history of the subscriber's recently viewed programs. The Office concedes that Harrison does not teach or suggest such aspects and, in an attempt to make up for the conceded deficiency, references Williams et al. In particular, the Office references column 8, lines 12-19, and column 11, lines 1-23, to teach these aspects. The Office asserts that such modification would be obvious because Harrison would allow the use to better personalize a television viewing experience. However, the Office does not cite either reference or the knowledge generally available to one of ordinary skill in the art to support this assertion. Thus, the Office has failed to provide the requisite suggestion or motivation for such modification to Harrison, and, thus, has not established a *prima facie* case of obviousness.

In addition, column 8, lines 12-19, of Williams et al. discloses that the controller 104 scans programming information in a database to find programs that may be of particular interest to the user based on the user's profile, and column 10, line 65, to column 11, line 23, of Williams et al. discloses that identifying programs that may be of particular interest to the user entails searching a program database for keywords that *match* user profile preferences such as genre information. Column 6, lines 33-56, and column 7, lines 52-67, note that historical viewing information may be included in the user preference information.

Thus, the referenced sections of Williams et al. teach locating programs that may be of interest by *matching* historical viewing data with program data. However, Williams et al. is silent regarding an executing script that *extrapolates* (infers) from a viewing history to rank programs for display or recording as recited in the subject claim. Therefore, the rejection of claim 28 should be withdrawn.

Claim 30, which depends from independent claim 15, has been amended herein to recite that the executing script *automatically* records a program designated to be displayed instead of displaying the program when the user is concurrently viewing a different program. Support for this amendment is found at page 16, lines 4-16, of the application. Neither Harrison nor Williams et al. teach or suggest automatic recording.

As noted by the Office, Williams et al. allows a user to forego watching a suggested program and instead manually elect to record the program after the controller 104 prompts the user with a recording option. (See column 8, lines 12-19 and column 11, lines 1-23 and 45-51). Thus, Williams et al. teaches that the user may *manually invoke recording*. However, Williams et al. is silent regarding an executing script that *automatically* records a program designated to be displayed instead of displaying the program when the user is concurrently viewing a different program as recited in claim 30. Therefore, this rejection should be withdrawn.

The Rejection of claim 27 under 35 U.S.C. 103(a) as being unpatentable over Harrison in view of Holtz et al.

Claim 27 stands rejected under 35 U.S.C. 103(a) as being unpatentable over Harrison in view of Holtz et al. This rejection should be withdrawn because the purported modification to Harrison with the teachings of Holtz et al. does not teach or suggest all the claim limitations, and, thus, the Office has failed to establish a *prima facie* case of obviousness.

To establish a *prima facie* case of obviousness.... [T]he prior art reference (or references when combined) must teach or suggest all the claim limitations.

MPEP §2143

Claim 27, which depends from claim 11, recites that the executable script includes

instructions for *selectively* skipping commercials while recording the selected broadcast programming. The Office concedes that Harrison does not teach or suggest such aspects and, in an attempt to make up for the conceded deficiency, references Holtz et al. In particular, the Office references Holtz et al. page 25, paragraph [0307] to teach this aspect.

Holtz et al. is directed toward producing and distributing enhanced media downstreams. Holtz et al. discloses a multimedia system that collects/assembles a media production such as a news program or television programming. The media production is available for retrieval and distribution across a network, and a user can display and interact with the media production. The media production is displayed with various enhancements such as commercials, active banners, and sponsorship buttons. The advertisements are priced according to factors that measure the likelihood of an advertisement actually being presented or viewed by users most likely to purchase the advertised item or service. Metrics are collected to invoice and apportion income derived from the advertisements among the network participants, including a portal host and/or producer of the content. (See Abstract).

As disclosed on page 25, paragraphs [0306] – [0309], which are in relation to subscription based services, audio or video (advertisements) commercials are fed through a commercial feed. A user not interested in viewing such commercials may delay or skip the commercial feed. This can be achieved through a pre-set profile or a user interface. If the user elects to skip the commercial feed, the sponsor of the commercial feed would advertise the product in an electronic banner on the viewing screen since advertisement revenue typically cannot be generated if the user foregoes the advertisement. Thus, in place of an audio or video commercial, an electronic banner would promote the product in a window adjacent to and concurrent with the content stream. Alternatively, the user is charged a subscription fee to receive commercial-free content, and the subscription fee is apportioned among the advertisements that are linked to the commercial-free feed.

Thus, these paragraphs of Holtz et al. teach that a user may elect to have advertisements displayed as electronic banners rather than as audio or video commercials or skipped altogether for commercial-free program viewing. In contrast, the subject claim recites executing a script

Application No. 10/028,574
Amdt. Dated: March 19, 2007
Reply to Office Action Dated: December 18, 2006
Customer No.: 24737

that includes instructions for selectively skipping commercials while recording the selected broadcast programming. Accordingly, this rejection should be withdrawn.

The Rejection of claim 29 under 35 U.S.C. 103(a) as being unpatentable over Harrison in view of Lewis (US Pub. No. 2003/0040962)

Claim 29 stands rejected under 35 U.S.C. 103(a) as being unpatentable over Harrison in view of Lewis. The rejection of claim 29 should be withdrawn because the Office has failed to provide the requisite suggestion or motivation to modify Harrison with the teaching of Lewis as purported in the Office Action, and, thus, the Office has failed to establish a *prima facie* case of obviousness.

To establish a *prima facie* case of obviousness.... [T]here must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings.

The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure. *In re Vaeck*, 947 F.2d 488 (Fed. Cir. 1991).

MPEP §2143

Claim 29, which depends from claim 15, recites using the executing script for controlling tradeoffs between recording time, picture quality, and available storage space. The Office concedes that Harrison does not teach or suggest such aspects and, in an attempt to make up for the conceded deficiency, references Lewis, page 15, paragraph [0156]. The Office asserts that the motivation to modify Harrison as such is to provide greater user control over a television recording device. However, the Office does not cite either reference or the knowledge generally available to one of ordinary skill in the art to support this assertion. Thus, the Office has failed to provide the requisite suggestion or motivation for such modification to Harrison, and, thus, has not established a *prima facie* case of obviousness. In view of the above, it is respectfully requested that this rejection be withdrawn.

Application No. 10/028,574
Amdt. Dated: March 19, 2007
Reply to Office Action Dated: December 18, 2006
Customer No.: 24737

Conclusion

In view of the foregoing, it is submitted that the subject claims distinguish patentably and non-obviously over the prior art of record. An early indication of allowability is earnestly solicited.

Respectfully submitted,

DRIGGS, HOGG & FRY CO., L.P.A.



Anthony M. Del Zoppo, III Reg. No. 51,606

Driggs, Hogg & Fry Co., L.P.A.

38500 Chardon Road

Willoughby Hills, Ohio 44094

Phone: 1.440.391.5100

Fax: 1.440.391.5101

Direct all correspondence to:

Yan Glickberg, Registration No. 51,742

US PHILIPS CORPORATION

P.O. Box 3001

Briarcliff Manor, NY 10510-8001

Phone: (914) 333-9608

Fax: (914) 332-0615